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UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
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AUG 27 2003

Paper No. 9

OFFICE OF THE DIRECTOR
TC 3600

In re Application of
Andrea Griseri et al
Application No. 09/904,234
Filed: July 12, 2001
For: BEARING-HUB UNIT FOR MOTOR
VEHICLE WHEEL

DECISION ON PETITION
FOR SUPERVISORY REVIEW
UNDER 37 CFR 1.181

This is a decision on applicant's petition under 37 CFR 1.181 filed May 15, 2003 requesting withdrawal of the holding of abandonment of the instant application.

The petition is **GRANTED**.

The record reflects that on September 13, 2002 an Office action was mailed requiring an election of a single disclosed species for prosecution on the merits and a listing of all claims readable thereon between the disclosed species shown in Figures 2-3 and Figure 4. Claim 1 was indicated as being generic. The examiner further stated that an indication that "at least" claims would not be an indication of all the claims readable upon the elected species. On December 23, 2002, applicants' elected with traverse the embodiment of Figure 4 and indicated that at least claims 1, 3, 4, and 5 read upon the elected species. On April 28, 2003 an Office action was mailed indicating that the reply filed on December 23, 2002 was not fully responsive as applicants' statement of "at least" claims 1, 3, 4, and 5 read upon the elected species is not an indication of all the claims readable upon the elected species and that a fully responsive reply must be filed within the statutory period for reply provided for in the Office action mailed September 13, 2002.

Applicants' argue that the reply of December 23, 2002 was fully responsive because it identified claims 1, 3, 4, and 5 as being elected. MPEP 809.02(a) states to be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. 37 CFR 1.135(c) states that when reply by applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete

reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under 37 CFR 1.134 to supply the omission. MPEP 714.03 states that where an amendment is *bona fide* but contains a serious omission, the examiner should if there is insufficient time remaining for applicants' reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). Since applicants' response to the Office action of September 13, 2002 indicates that "at least" claims 1, 3, 4, and 5 read upon the elected species it does not provide an explicit indication of all of the claims which are readable upon the elected species. Therefore, the examiner's holding of applicants' reply filed December 23, 2002 as non-responsive is proper. However, in accordance with MPEP 714.03 the examiner should have set a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). Accordingly, applicant's request to withdraw the holding of abandonment of the instant application is granted.

The reply filed on December 23, 2002 is not fully responsive to the prior Office action because it fails to provide an explicit indication of all claims readable upon the elected species. Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

The application will be returned to the central files of Technology Center 3600 to await applicants' reply.



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db/snm: 8/18/03

